UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/220,953	03/31/94	BERIONT	W 903816CON1

EXAMINER
WEBSTER, B

ART UNIT	PAPER NUMBER
2614	21

DATE MAILED: 02/22/95

26M1/0222

PETER XIARHOS, ESQ.
GTE TELECOMMUNICATIONS
PRODUCTS & SERVICES
40 SYLVAN RD. MS31
WALTHAM, MA 02254

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☒ Responsive to communication filed on 12/14/94 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), -0- days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice of Draftsman's Patent Drawing Review, PTO-948.
3. ☒ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____.

Part II SUMMARY OF ACTION

1. ☒ Claims 1-7 are pending in the application.

   Of the above, claims _____ are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☒ Claims 1-7 are rejected.

5. ☐ Claims _____ are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____. has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).

12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

Part III DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

2. Claims 1-7 are rejected under 35 U.S.C. § 103 as being unpatentable over Gromen. Consider claims 1-7, Gromen recites a method for serial transmission in which a word which consists of individual bits is input into a word register, all of the bits are examined sequentially and upon detecting a sequence of bits, replacing the bits predetermined value and transmitting the value

in-place of the bits. Whereby, the apparatus contains a register for storing the bits, detector for sequentially monitoring the bits for consecutive bits, and an output means for transmitting the predetermined value when a match was found (See fig.#1, abstract,summary,col.3,line 10 to col.5,line 65). However, where the Gromen reference refers to a multiplicity of consecutive bits, the claimed invention refers to one two consecutive bits. This fact does not raise the scope of the claimed invention above the teaching of Gromen. Therefore, it would have been obvious to a person with ordinary skill in the art to insert a bit after any amount of consecutive identical bits given the teachings of Gromen because the number of bits being replaced (2 or 8) does not change the scope of the invention.

Response to Amendment

3. Applicant's arguments filed December 14,1994 have been fully considered but they are not deemed to be persuasive. The applicant recites, "Although Gromen and the present invention both transmit SYNC symbols in their respective signal processing apparatus, the conditions under which such SYNC symbols are used are completely different and render claims 1-7 patentable over Gromen." The examiner concedes that the SYNC bits presented in the claimed invention and Gromen have different uses, however, that fact does not render claims 1-7 patentable over Gromen. The

two inventions are functionally equivalent and the teachings of Gromen still carry out the same operations as that of the claimed invention. Whether Gromen and the applicant use the same terms for the same operations is irrelevant, the operations that are being carried out by the two inventions do not distinguish one from another. And therefore, claims 1-7, are not patentable over Gromen.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryan Webster whose telephone number is (703) 308-6607.

Bwebster
February 17, 1995

STEPHEN CHIN
SUPERVISORY PRIMARY EXAMINER
GROUP 2600